



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q55595

Kenichi MIYAZAKI

Appln. No.: 09/386,000

Group Art Unit: 3651

Confirmation No.: 9906

Examiner: Patrick H. MACKEY

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SUBSTITUTE REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Substitute Reply Brief in response to the Examiner's Answer dated August 8, 2005. Entry of this Substitute Reply Brief is respectfully requested.

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SUMMARY OF PROCEEDINGS SURROUNDING REMAND

The Examiner's Answer dated August 8, 2005, the Examiner, for the first time, set forth additional details regarding many of the rejections issued during the prosecution of the above-identified application. For example, the answer includes four pages of claim charts showing how the Examiner has been reading various claims on the Digital ES publication and the Microstation Magazine (MSM Online) printout, which allegedly relate to the OCE 9400 device.

In formulating a response to the Examiner's elaboration on the details of his rejection based on the OCE 9400 device, Appellant discovered the User Manual for the OCE 9400 device, which clearly shows that structure and operation of the device is significantly different than how the Examiner characterized its structure and operation in the Examiner's Answer. Thus, Appellant relied on the disclosure of the user manual in its Reply Brief filed on October 11, 2005, to rebut the Examiner's reasoning. On November 4, 2005, the Examiner issued a Communication indicating that he entered the Reply Brief and has considered it.

On March 15, 2006, the Board remanded the case back to the Examiner and noted:

On October 11, 2005 appellant filed a reply brief including 41 pages of argument and comments concerning each of the nine rejections maintained by the examiner on appeal and separately addressing the examiner's various positions in the answer with regard to nearly all of the thirteen claims on appeal, eight of which are independent claims. The reply brief also included attached evidence [*i.e.*, the User Manual for the OCE 9400 device] relied upon by appellant in the arguments set forth on pages 30-35 of the reply brief. Our review of the record would appear to show that the reply brief represents appellant's *first opportunity* to respond to the full details of many of the examiner's rejections on appeal.

(Page 2 of March 15, 2006, Remand to the Examiner (emphasis added)). As noted above, the Board seems to acknowledge that the Reply Brief represented Appellant's first

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opportunity to respond to the Examiner's detailed reasons for rejecting the claims over the OCE 9400 device.

Furthermore, the Board noted that the Examiner's Communication of November 4, 2005, indicating that the Reply Brief has been "entered and considered" was "woefully inadequate in this particular case, since it fails to provide [the Board] with [the Examiner's] views concerning the numerous and specific arguments presented by appellant in the 41 pages of the reply brief." (Pages 2 and 3 of March 15, 2006, Remand to the Examiner). As such, the Board stated that:

[W]e remand the application to the examiner for a full and complete response on the record to the many arguments and issues raised by appellant in the reply brief. A supplemental examiner's answer responsive to the above-noted reply brief would appear to be necessary.

(Page 3 of March 15, 2006, Remand to the Examiner (emphasis added)). Accordingly, the Board instructed the Examiner to fully and completely respond to the arguments in the Reply Brief and indicated that a Supplemental Examiner's Answer responsive to the Reply Brief appears necessary.

Instead of responding to Appellant's numerous and specific arguments in the Reply Brief as the Board instructed, the Examiner issued a Supplemental Examiner's Answer that merely indicates that the Examiner has changed his mind and is not considering the Reply Brief because it relies on the User Manual for the OCE 9400 device.

Appellant has concurrently submitted a Petition under 37 C.F.R. § 1.182 and/or 1.183 requesting the Examiner to enter the Reply Brief dated October 11, 2005. However, in the event that the Petition is denied, Appellant submits this Substitute Reply Brief.

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STATUS OF CLAIMS

As noted in the Appeal Brief filed on June 22, 2005, claims 1-6, 13, 15-18, 26 and 31 are currently pending and are being appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

As noted in the Appeal Brief, the grounds of rejection to be reviewed on appeal are as follows:

1. Claims 1-6, 13, and 16-18 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.
2. Claims 1, 5, 6, 16, 26, and 31 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,838,354 to Yamada et al. (hereinafter “Yamada”).
3. Claims 13, 18, 26, and 31 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by EP 0 727 375 to Orbons et al. (hereinafter “Orbons”).
4. Claims 13, 17, 18, 26, and 31 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the IP-4000 device.
5. Claims 1, 3, 5, 6, 13, 17, 18, 26, and 31 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the OCE 9400 device.
6. Claims 16, 26, and 31 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by JP 63-154558 to Takumi (hereinafter “Takumi”).
7. Claim 2 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yamada in view of Orbons.

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8. Claims 13 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 938,885 to McCulley (hereinafter “McCulley”) in view of U.S. Patent No. 1,128,730 to Smedal (hereinafter “Smedal”).

9. Claim 15 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 2,300,276 to Hageman (hereinafter “Hageman”) in view of U.S. Patent No. 2,904,332 to Metzner (hereinafter “Metzner”).

ARGUMENT

I. Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-6, 13, and 16-18 remain rejected as being indefinite under 35 U.S.C. § 112, second paragraph, because the height of the claimed sheet feeding area is allegedly unclear. Appellant respectfully submits that the claims satisfy the requirements of 35 U.S.C. § 112, second paragraph.

A. Claim 1

Claim 1 states that the paper feeding unit is located at a height that enables a user, who is approximately 170 cm tall and who is standing in front of the printer, to execute a paper feeding process, which includes replacing a roll paper. On page 3 of the Examiner's Answer, the Examiner contends that this phrase is unclear because the claim allegedly does not define the height of the paper feeding unit. Appellant respectfully disagrees.

For example, the claim states that the unit is located at a height that enables a user, who is approximately 170 cm tall and standing in front of the printer, to execute the paper feeding process. Such a limitation is clearly defines the metes and bounds of the claimed invention to those skilled in the art. Specifically, if a printer has a paper feed unit that is located at a height that does not enable a user, who is approximately 170 cm tall and standing in front of the printer, to execute the process, the limitation does not read on the printer. On the other hand, if the unit is located at a height that enables the user to execute the process, the limitation reads on the claim.

In *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986), the

Federal Circuit held that an analogous claim limitation was definite under 35 U.S.C. § 112, second paragraph. In *Orthokinetics*, the patent-in-suit (*i.e.*, the ‘867 patent) related to a collapsible wheel chair, and claim 1 of the ‘867 patent states, in part:

1. In a wheel chair having a seat portion, a front leg portion, and a rear wheel assembly, the improvement wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof

Id. at 1568 (emphasis added).

Prior to the Federal Circuit appeal, the district court held that the “so dimensioned” language was indefinite because

an individual desiring to build a noninfringing travel chair cannot tell whether that chair violates the [‘867] patent until he constructs a model and tests the model on vehicles ranging from a Honda Civic to a Lincoln Continental to a Checker cab. Without those cars, “so dimensioned” is without meaning.

Id. at 1575. However, the Federal Circuit disagreed and reversed the district court’s ruling because the “so dimensioned” limitation is definite and satisfies the requirements of 35 U.S.C. § 112, second paragraph. In its holding, the Federal Circuit noted that the claims require “that one desiring to build and use a travel chair must measure the space between the selected automobile’s doorframe and its seat and then dimension the front legs of the travel chair so they will fit in that particular space in that particular automobile.” *Id.* at 1576 (emphasis added). Moreover, the Court noted that the claims of the patent-in-suit “were intended to cover the use of the invention with various types of automobiles,” and the fact that “a particular chair on which the claims read may fit within some automobiles and not others is of no moment.” *Id.*

Since automobiles are made in various sizes and since the phrase “so dimensioned” is as

accurate as the subject matter permits because, the Federal Circuit held that the claim satisfies the requirements of 35 U.S.C. § 112, second paragraph. *Id.* Moreover, the Court noted that “[t]he patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.” *Id.*

As described above, the claim in *Orthokinetics* relates to a wheel chair having a front leg portion that is “so dimensioned” as to be insertable between the doorframe of an automobile and a seat of the automobile. In other words, the claim defines the dimension of the front leg portion of the wheel chair by referring to something (*i.e.*, the automobile), which is external to the wheel chair.

Similarly, in the present application, claim 1 states that the paper feeding unit is located at a height that enables a user, who is approximately 170 cm tall and who is standing in front of the printer, to execute a paper feeding process, which includes replacing a roll paper. Therefore, as in *Orthokinetics*, the claim defines the dimension or height of the paper feeding unit of the printer by referring to something (*i.e.*, a user), which is external to the printer. In fact, the claim of the present application is “more definite” than the claim at issue in *Orthokinetics* because the claim actually specifies the height of the user (*i.e.*, 170 cm), whereas the claim at issue in *Orthokinetics* does not specify any dimensions of the automobile or the distance between the doorframe and the seat.

The Examiner also argues that, since the claim uses the “user” as a reference point for the height of the unit, he is unsure whether or not Appellant is claiming a person. (Page 3 of

Examiner's Answer). Appellant submits that the claim clearly claims a printer and not a human being, and as in the *Orthokinetics* claim, the claim simply defines the height of the paper feeding unit by referring to something that is external to the claimed invention.

On page 3 of the Examiner's Answer, the Examiner also seems to question whether the claim covers a printer when a user, who is 160 cm tall, uses the printer and if it covers a printer when a user, who is sitting or kneeling, uses the printer. Appellant submits that the claim covers the printer, and not any particular user that is using the printer. As long as the printer has a paper feeding unit is located at a height that enables a user, who is approximately 170 cm tall and who is standing in front of the printer to execute the paper feeding process, such limitation reads on the printer, regardless of whether a user who is 160 cm tall, who is sitting, who is kneeling, etc., is using the printer.

As noted in *Orthokinetics*, the fact that a particular wheel chair, which falls within the scope of the claims, "fit[s] within some automobiles and not others is of no moment." *Id.* at 1576. Similarly, in the present application, the fact that the printer is used by users that are not 170 cm tall and that are not standing is likewise of "no moment" with respect to the definiteness of claim 1.

Also, the Examiner responds to Appellant's arguments in the Appeal Brief on pages 15 and 16 of the Examiner's Answer. In his response, the Examiner states that he invited the Appellant to clearly define the height or range of heights of the printer but that Appellant declined to further amend the claims. However, such an amendment would unnecessarily narrow claims and is not necessary to satisfy the requirements of 35 U.S.C. § 112, second

paragraph. *See, e.g.*, M.P.E.P. § 2173.04.

Moreover, as described in an illustrative embodiment, the specification teaches that “the height of the user who is 170 mm tall is used to determine the height of the paper feeding unit....” (Page 11, lines 4-6, of the present application). Therefore, while the Appellant could have claimed the height of the paper feeding unit with specific ranges and numbers, it chose to claim the height based on the height of the user.

The Examiner also contends that claim 1 is indefinite because the height of the paper feeding unit is defined based on a “point of reference” (*i.e.*, a user who is standing and is 170 cm tall) which allegedly is not ascertainable. (Page 15 of the Examiner’s Answer). As explained above, in conjunction with *Orthokinetics*, the claimed “point of reference” of the user who is standing and is 170 cm tall is an ascertainable reference and satisfies the requirements of the 35 U.S.C. § 112, second paragraph.

In addition, the Examiner notes that one user, who is 170 cm tall, may have “extremely short arms as the result of an accident or birth defect such that he or she squat or sit down to execute the paper feeding process” and that another user may have normal length arms. (Page 16 of the Examiner’s Answer). Therefore, the Examiner argues that a manufacturer cannot determine whether or not his or her printer falls within the scope of claim 1.

Again, the *Orthokinetics* case squarely addresses and resolves the issue that the Examiner raises. First, deciding whether or not a claim is indefinite, 35 U.S.C. § 112, second paragraph, requires determining what one skilled in the art would understand the claim limitation to mean when the claim is read in light of the specification. *Id.* at 1576 (citing *Seattle Box Co. v.*

Industrial Crating & Packing Inc., 731 F.2d 818, 826 (Fed. Cir. 1984)). Upon reviewing Fig. 1 of the present application and reading the description of the embodiments in the specification, one skilled in the art would clearly understand that the height of the paper feeding unit is determined based on a normally proportioned user who is 170 cm tall.

Second, *Orthokinetics* considered an argument virtually identical to the Examiner's hypothetical argument and rejected it. Specifically, in that case, the Federal Circuit acknowledged district court's conclusion that a manufacturer desiring to build a non-infringing wheel chair cannot tell whether his or her chair violates the patent-in-suit because it would require him to test the wheel chair to see if it is "so dimensioned" to fit within different types of vehicles "ranging from a Honda Civic to a Lincoln Continental to a Checker cab." *Id.* at 1575. Nonetheless, the Federal Circuit held that the claims of the patent-in-suit "were intended to cover the use of the invention with various types of automobiles," and the fact that "a particular chair on which the claims read may fit within some automobiles and not others is of no moment." *Id.* at 1576. In the present application, the fact that one user, who is 170 cm tall and who has "extremely short arms as the result of an accident or a birth defect," cannot execute the paper feeding process is likewise of "no moment," and claim 1 is definite.

B. Claim 2

Since claim 2 depends upon claim 1 and does not further describe the claimed height of the paper feeding unit, Appellant submits that it is patentable for the reasons presented above.

C. Claim 3

Claim 3 relates to a printer that has a paper feeding unit that is “located at a height” that enables a user standing in front of the printer to execute a paper feeding process including replacement of a roll paper. The Examiner contends that the claimed height is indefinite for the reasons that he maintains the height recited in claim 1 is indefinite.

Although claim 3 does not specifically recite the height of the user, Appellant submits that the claimed height satisfies the requirements of 35 U.S.C. § 112, second paragraph. While the specification describes an embodiment in which the height of the paper feeding unit is set based on a user that is 170 cm tall, the specification also describes an exemplary embodiment in which different types of users may use the printer. In this embodiment, the “paper feeding unit 30 can be adjusted, [and thus,] it can be set to provide an optimal height for an individual user.” (Page 11, lines 6-7, of the specification).

Therefore, the Appellant contemplated locating the height of the paper feeding unit with users having many different heights and dimensions. Therefore, limiting the invention by specifically claiming a particular height or range of heights of the paper feed unit would unduly narrow the scope of the claim. In other words, since reciting a specific height or range in the claim would prevent the claim from covering certain printers incorporating one of the novel features of the invention, the language of the claims is as precise as the claimed subject matter permits and is definite under 35 U.S.C. § 112, second paragraph.

Again, this issue was squarely before the Federal Circuit in the *Orthokinetics* case, and the Court found the claim to be definite. Specifically, the Court noted that the patentee intended

the claims to cover wheel chairs that are used with various types of automobiles and that a particular wheel chair, which falls within the claims, may fit within some automobiles and not fit in other automobiles. *Orthokinetics*, 806 F.2d 1576. Since the sizes of different automobiles vary, the Court held that claiming a dimension of the wheel chair based on a general dimension of an unspecified automobile is as precise as the subject matter permits.

Therefore, claim 3 is definite under 35 U.S.C. § 112, second paragraph, based on the arguments above. Also, claim 3 is definite based on the arguments presented above in conjunction with claim 1.

D. Claim 4

Appellant submits that claim 4 is definite for reasons that are similar to the reasons why claim 3 is definite.

E. Claims 5 and 6

Since claims 5 and 6 depend upon claim 1 and do not further describe the claimed height of the paper feeding unit, Appellant submits that they are patentable for the reasons presented above in conjunction with claim 1.

F. Claims 13 and 16

Appellant submits that claims 13 and 16 are definite for reasons that are similar to the reasons why claim 1 is definite. Also, since claims 13 and 16 specify that the user can set up the print medium without having to bend substantially at the waist, such claims are “further definite.”

G. Claim 17

Since claim 17 depends upon claim 16 and does not further describe the claimed height of the paper feeding unit, Appellant submits that it is patentable for the reasons presented above in conjunction with claim 16.

H. Claim 18

Appellant submits that claim 18 is definite for reasons that are similar to the reasons why claims 13 and 16 are definite.

II. Rejection under 35 U.S.C. § 102(e) over Yamada

Claims 1, 5, 6, 16, 26, and 31 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Yamada. Appellant submits that the claims are patentable over the reference.

A. Claim 1

1. Yamada does not disclose the claimed ability to feed the roll of paper, sheet of paper, and stiff carton

As recited in claim 1, the printer has a paper feeding unit capable of feeding at least one roll of paper, at least one substantially flat sheet of paper, and at least one stiff carton. However, as described in the Appeal Brief, Yamada does not suggest the features above. While Fig. 1 of Yamada does, in fact, describe a paper feed station 1 that can accommodate roll sheets 101, 102, and 103, it does not remotely suggest that the paper feed station 1 can feed anything other than a roll of paper, let alone a substantially flat sheet of paper and stiff carton.

On page 4 of the Examiner's Answer, the Examiner contends that Yamada discloses the claimed stiff carton as item 101 in Fig. 1, but Appellant respectfully disagrees. For example, Yamada clearly discloses that both the items 101 and 102 are rolls of paper. (Fig. 1; column 5,

lines 31-50). While column 5, lines 23-30, explains that the paper feed station can feed rolls of paper, film, or cloth, the reference still does not suggest feeding a substantially flat sheet of paper and a stiff carton. In addition, on page 4 of the Examiner's Answer, the Examiner does not even contend that Yamada's feeding station 1 is operable to feed a substantially flat sheet of paper.

On page 7 of the Examiner's Answer, the Examiner seems to maintain that column 5, lines 35-55, of Yamada teaches all three types of the recording media. However, this portion of Yamada merely describes the rolls of paper 101 and 102 and does not suggest that the station 1 can feed a substantially flat sheet of paper and stiff carton.

On page 16 of the Examiner's Answer, the Examiner contends that the claim language relating to the roll of paper, substantially flat sheet of paper, and stiff carton does not limit the claim and cites M.P.E.P. § 2115 in support of his position. However, M.P.E.P. § 2115 does not apply to the issues at hand, and the case law cited in the section are factually different from the facts of the present case.

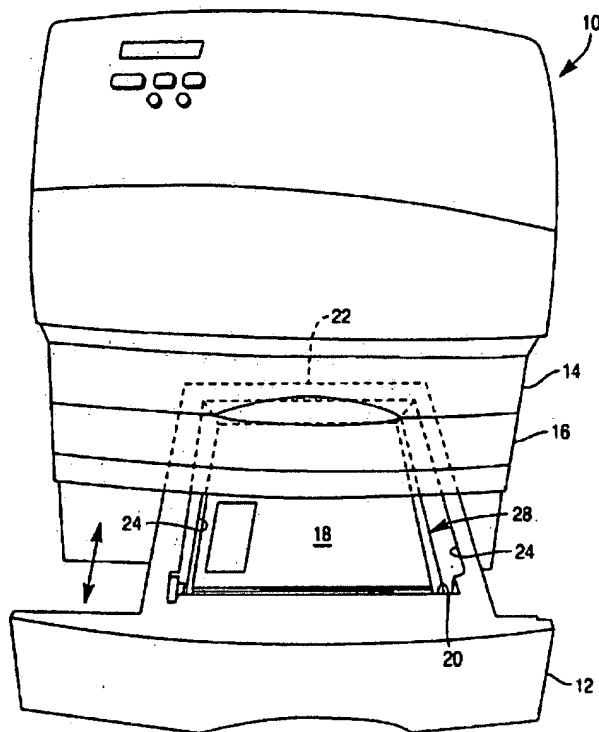
For example, in *In re Casey*, 370 F.2d 576 (C.C.P.A. 1967), the Court affirmed a rejection of a claim under 35 U.S.C. § 103 over the Kienzle reference. The claim related to a taping machine comprising a supporting structure and a brush. Also, the brush is attached to the supporting structure and is "formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere...." *Id.* at 577. Although Kienzle does not suggest adhering adhesive tape to the free ends of the bristles, the Court upheld the obviousness rejection based on the reference because "[t]he references in claim 1 to adhesive tape handling do not expressly or impliedly require any particular structure in

addition to that of Kienzle.” *Id.* at 580-81 (emphasis added).

On the other hand, in the present application, the paper feeding unit of claim 1 is capable of feeding at least one roll of paper, at least one substantially flat sheet of paper, and at least one stiff carton, and such language implies that the claimed unit must have structure that enables it to feed these three types of recording media. For example, as shown in the illustrative, non-limiting embodiment in Figs. 1 and 3 of the present application, the paper feeding unit 30 accommodates rolls of paper 3 on spindles 4 and 5, and the unit 30 feeds the paper on the rolls 3 to the printing unit 7. (Fig. 1). Also, a user can place a sheet of stiff carton 21 or a sheet of paper on top of the paper roll cover 28 and feed it to the printing unit 7. (Fig. 3; page 10, lines 11-14; page 12, lines 9-11).

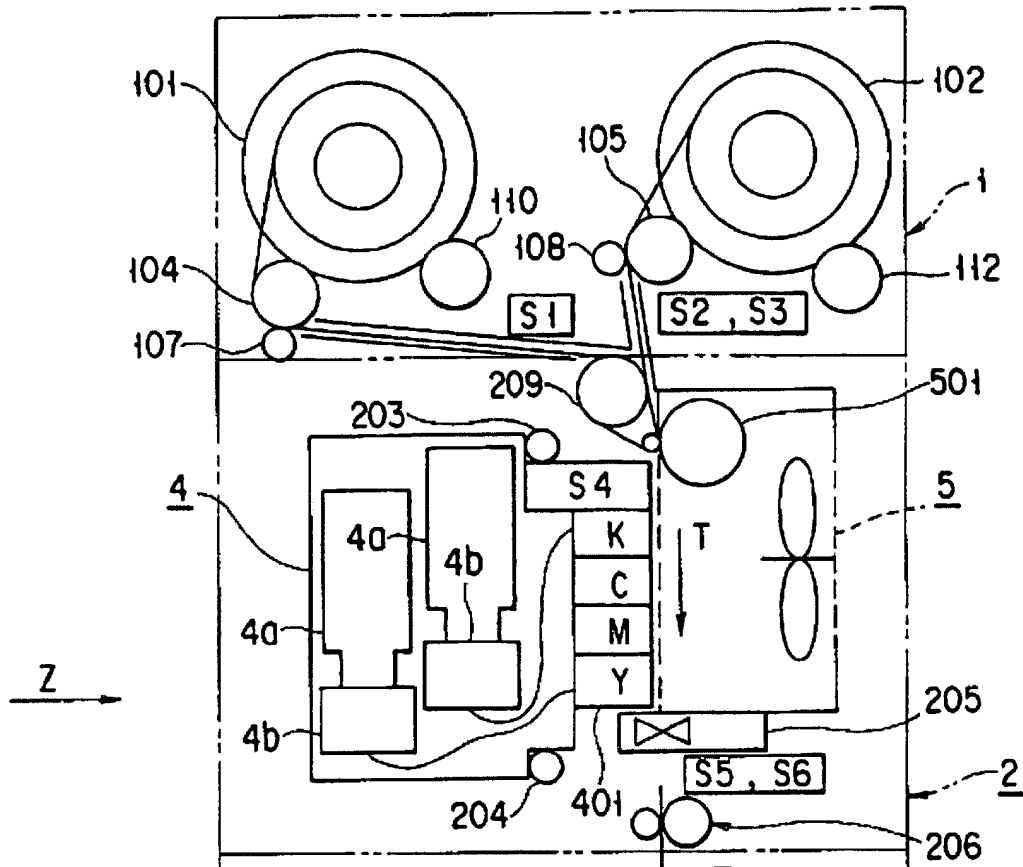
On the other hand, not all paper feeding units are capable of feeding a roll of paper, a substantially flat sheet of paper, and a stiff carton. For example, in U.S. Patent No. 6,939,068 to Rawlings et al. (“Rawlings”), Fig. 1 (reproduced below) shows an example of a printer 10 that has a paper feed tray 12, which is partly open in the figure and which feeds sheets of paper 18 to be printed.

FIG. 1



While the paper feed tray 12 has a structure that is capable of feeding sheets of paper 18, it clearly is not capable of feeding a roll of paper.

Also, as shown in Fig. 1 of Yamada (reproduced below), the paper feed station 1 accommodates rolls of paper 101 and 102 and feeds them to the recording station 2. During a printing operation, the paper from the roll 101 travels to the platen unit 5 by sequentially bending around the roller 104 and bending around the pinch holder 209. Similarly, the paper from the roll 102 travels to the unit 5 by bending around the roller 105 and the pinch holder 209.



As shown in the figure, no structure is provided to enable the paper feed station 1 to feed a sheet of paper and a stiff carton. In fact, the station 1 is incapable of feeding stiff carton because the stiff carton would not be able to bend around the rollers 104 and 105 and the pinch holder 209 without becoming jammed or damaged and/or without damaging components of the disclosed apparatus.

Since the claimed paper feeding unit (which is capable of feeding at least one roll of paper, at least one substantially flat sheet of paper, and at least one stiff carton) does not read on certain structures, such as the structure shown in the Rawlings and Yamada references and reads

on other structures, such as the structure shown in Figs. 1 and 3 of the present application, Appellant submits that the claim language expressly or impliedly requires particular structure. Therefore, M.P.E.P. § 2115 and the case law cited within the section, such as *In re Casey*, does not apply to the facts of the present appeal, and the claim language does, in fact, constitute claim limitations that the Examiner must consider in determining the patentability of the claim.

On page 17 of the Examiner's Answer, the Examiner argues that, even if the "roll of paper," "substantially flat sheet of paper," and "stiff carton" features are claim limitations, Yamada anticipates claim 1. Specifically, he notes that, on page 4 of the Amendment filed on May 10, 2004, Appellant stated that "a stiff carton is characterized as an example of a sheet of paper." The Examiner seems to interpret this statement as Appellant's admission that a stiff carton and a sheet of paper are the same thing.

Appellant respectfully disagrees. Assuming *arguendo* that a stiff carton is an example of a sheet of paper, Appellant's statement does not mean that a sheet of paper and a stiff carton are the same. For instance, while a bicycle is an example of a vehicle, vehicles include automobiles, airplanes, and spacecrafts. Thus, every vehicle is not a bicycle, and bicycles and vehicles are not the same.

In addition, claim 1 expressly recites the roll of paper, the sheet of paper, and the stiff carton as three separate items. Moreover, the non-limiting embodiments described in the specification distinguish the three items from each other. For instance, in the embodiment described on pages 9 and 10 of the present application, (1) a roll of paper has a width of about 210 mm to 1120 mm and has a diameter of 10 cm to 15 cm, (2) a sheet of paper has the same

width as the roll of paper, has a length of about 420 mm to 1580 mm, and has a thickness of less than 0.5 mm, and (3) a stiff carton has a thickness of 0.5 mm to 1.5 mm. Since both claim 1 and the specification treat the roll of paper, sheet of paper, and stiff carton as three separate items, the Examiner's argument that claim 1 only requires a roll of paper is unreasonable.

Furthermore, assuming *arguendo* that a stiff carton is a specific example of a sheet of paper, Yamada's disclosure of a generic roll of paper does not teach or suggest the specific stiff carton in claim 1. For example, under U.S. patent law, a claim that recites a container that is specifically filled with hydrogen gas is not anticipated by a prior art reference that discloses a container that is generally filled with gas, and a claim that specifically recites a metal rim supporting a rubber tire is not anticipated by a prior art reference that generally discloses a wheel. This basic proposition hold true despite the fact that hydrogen gas is a specific example of a gas and that a metal rim supporting a rubber tire is a specific example of a wheel.

On pages 17 and 18, the Examiner argues that, even if the roll of paper, sheet of paper, and stiff carton are three different items, Yamada anticipates claim 1 because the device shown in Fig. 1 of the reference is "capable of" feeding all three items. Appellant respectfully disagrees. For example, as described above, the Yamada device could not successfully feed a stiff carton by bending it around the rollers 104 and 105 and the pinch holder 209. Accordingly, claim 1 is patentable over the reference.

2. Yamada does not disclose a paper feeding unit that is located at the claimed height

Claim 1 states that the paper feeding unit is located at a height that enables a user, who is approximately 170 cm tall and standing in front of the printer, to execute a paper feeding

process. Yamada does not disclose any relationship between the paper feed station 1 and the height of a user and thus, does not suggest the claimed height. On page 4 of the Examiner's Answer, the Examiner does not allege that Yamada discloses this feature. Also, in the claim chart on page 7, the Examiner cites Fig. 1 as disclosing this limitation, but Fig. 1 does not illustrate a user and does not otherwise indicate the height of the station 1.

On page 18 of the Examiner's Answer, the Examiner states that "Yamada does not disclose anything that would prevent enables [sic: enabling] a user, who is approximately 170 cm tall, standing in front of the printer to execute the paper feeding process...." (Emphasis added). Since the Examiner has the burden of proving that Yamada discloses the claimed features, he must demonstrate that the claimed paper feeding unit is located at a height that enables the user to execute the paper feeding process. As such, his argument that Yamada does not disclose anything that prevents the user from executing the process does not even create a *prima facie* case that Yamada's paper feed station is located at the claimed height. For example, referring back to the wheel example discussed above, if the claim recites a metal rim supporting a rubber tire and the prior art generally discloses a wheel, the Examiner could not properly reject the claim over the prior art based on the argument that nothing in the prior art prevents the disclosed wheel from being a metal rim supporting a rubber tire.

In addition, Yamada does, in fact, seem to prevent the user from executing the paper feeding process that includes replacing a roll of paper and setting at least one of a sheet of paper and a stiff carton. For example, as described above, Yamada only discloses loading rolls or paper 101 and 102 and does not disclose setting the substantially flat sheets of paper or a stiff

carton. Thus, the paper feed station 1 of Yamada cannot be located at a height that enables the user to perform the claimed process.

B. Claims 5 and 6

Since claims 5 and 6 depend upon claim 1, Appellant submits that they are patentable at least by virtue of their dependency.

C. Claim 16

Claim 16 states that the sheet feeding area is positioned at a height at which a user, who is approximately 170 cm tall and standing in front of the printer, can set up a printing medium without having to bend substantially at the waist. As noted above, Fig. 1 and the other portions of Yamada do not disclose any relationship between the paper feeding station 1 and the height of a user and thus, does not suggest the claimed height.

In addition, even assuming *arguendo* that Yamada somehow discloses positioning the paper feed station 1 at a height at which a user, who is approximately 170 cm tall and standing in front of the printer, can set up the printing medium, claim 16 requires the user to be able to set up the printing medium without bending substantially at the waist. Since Yamada does not disclose any relationship between the paper feeding station 1 and the height of a user, it cannot suggest that the standing user can set up the printing medium without bending substantially at the waist.

D. Claim 26

Claim 26 recites a sheet feeding area that is operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm, and at least one stiff carton ranging in length from 420 mm to 730

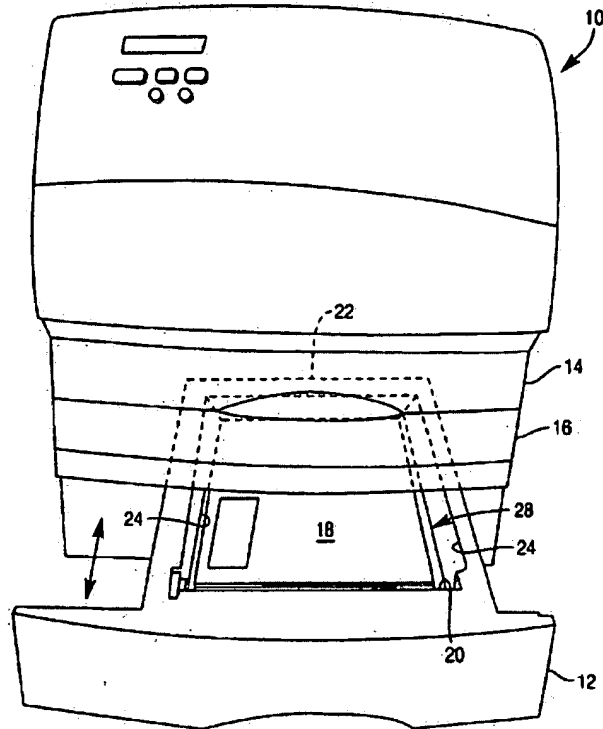
mm. Yamada does not even remotely disclose the claimed sheet feeding area that is able to feed the claimed sheet of paper ranging in length from 420 mm to 1580 mm or the stiff carton ranging in length from 420 mm to 730 mm, and the portions of the reference that the Examiner cites on page 12 of the Examiner's Answer does not suggest these types of media or their respective dimensions.

On pages 18 and 19 of the Examiner's Answer, the Examiner argues that the claimed media and their dimensions do not constitute claim limitations because they impart no structural limitations to the claim. Appellant's respectfully disagree.

For reason that are similar to the reasons presented in conjunction with claim 1, a sheet feeding area that is operable to feed a plurality of paper rolls, a substantially flat sheet of paper, and a stiff carton imparts structure to the claim because some printers cannot feed multiple paper rolls (such as the Rawlings device), other printers cannot feed a sheet of paper (such as the Yamada device), and yet other printers cannot feed stiff carton (such as the Yamada device). On the other hand, some printers can feed multiple paper rolls, a sheets of paper, and a stiff carton, such as the printer shown in Figs. 1 and 3 of the present application. Therefore, the recording media do impart structural limitations to the printer recited in claim 26.

Also, the dimensions of the recording media likewise impart structure to the claimed printer. For example, as shown in Fig. 1 of Rawlings (reproduced below), if the paper feed tray 12 of the printer 10 has a length that can accommodate only "A4" sized paper (which is 297 mm long), the tray 12 would not be able to feed a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm.

FIG. 1



Accordingly, claim 26 would not read on the Rawlings printer, and thus, the claimed dimensions do, in fact, impart structural limitations to the printer.

On page 19 of the Examiner's Answer, the Examiner argues that, even if the claimed features limit the claim, Yamada anticipates claim 26 because the claim only requires a roll of paper and does not require a substantially flat sheet of paper or a stiff carton. The Examiner basis this arguments on Appellant's statement in the Amendment filed on May 10, 2004, and discussed above. Appellant respectfully submits that the Examiner's argument is improper for the reasons presented above.

In addition, even assuming *arguendo* that the three types of the claimed recording media

read on the rolls of paper 101, 102, and 103 in Yamada, the reference does not suggest all of the claimed dimensions for the media. For example, claim 26 states that the stiff carton ranges in length from 420 mm to 730 mm. The Examiner contends that column 5, lines 45-50, suggest this dimension, but this disclosure only describes the widths of the rolls 101, 102, and 103.

Accordingly, Yamada does not disclose or suggest the features of claim 26.

Finally, on page 19 of the Examiner's Answer, the Examiner contends that Yamada anticipates claim 26 because it does not disclose anything that would render it incapable of feeding the claimed recording media. Appellant respectfully disagrees because this type of proof does not set forth a *prima facie* case of unpatentability and is incorrect technically incorrect for the reasons presented above.

E. Claim 31

Claim 31 depends upon claim 26, and thus, it is patentable at least by virtue of its dependency. Also, claim 31 is patentable for additional reasons.

For example, claim 31 states that flat sheet of paper has a thickness of less than 0.5 mm and that the stiff carton has a thickness ranging from 0.5 mm to 1.5 mm. The Examiner presents absolutely no proof that the print feed station 1 in Yamada can feed a stiff carton having the claimed thickness.

In addition, on page 19 of the Examiner's Answer, the Examiner contends that the stiff carton and the sheet of paper are the same thing. However, since claim 31 states that the paper has a thickness less than 0.5 mm and that the carton has a thickness ranging from 0.5 mm to 1.0 mm, the paper and carton clearly are not the same thing. As such, no matter how one rolls,

stiffens, or flattens a sheet of paper having a thickness of 0.5 mm, he or she cannot produce a carton having a thickness ranging from 0.5 mm to 1.0 mm. Therefore, Yamada does not disclose or teach the features in claim 31.

III. Rejection under 35 U.S.C. § 102(b) over Orbons

Claims 13, 18, 26, and 31 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Orbons. Appellant submits that the claims are patentable over the reference.

A. Claim 13

Claim 13 states that the printer comprises a sheet feeding area that is positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level. On the other hand, Orbons does not disclose or suggest the features above.

For example, as noted in the Appeal Brief, Figs. 1 and 2 of Orbons show a channel 35 that is formed in a paneling part or worktop 33, and the worktop 33 is formed at a “working height for a standing operator.” (Fig. 1; abstract; column 3, lines 34-36). The operator can place a roll of print media 16 in the channel 35 so that the operator can place a spindle 31 through a hollow core 30 of the roll 16 before loading the roll 16 into the feed unit 2. (Fig. 1; abstract; column 3, lines 36-40; column 4, line 54, to column 5, line 2). Since the feed unit 2 is located below the worktop 33 with the channel 35, the operator must significantly bend to load the rolls 16. (Fig. 1; column 5, lines 2-7). Accordingly, claim 13 is patentable over the reference.

Also, Appellant submits that the arguments above in conjunction with the rejections

under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 102(e) over Yamada refute the points that the Examiner raises on pages 20 and 21 with respect to claim 13.

B. Claim 18

Since claim 18 contains features that are similar to the features contained in claim 13, Appellant submits that claim 18 is patentable for similar reasons.

Also, claim 18 further states that a paper feeding path extends straight from the paper feeding area to the paper discharge area via a printing area. On the other hand, as clearly shown in Fig. 1 of Orbons, the paper feeding path does not extend straight from the feed unit 2 via the printing area 1 to the discharge unit 10. Therefore, claim 18 is further patentable over Orbons.

In addition, Appellant submits that the previous arguments refute the points that the Examiner raises on pages 20 and 21 with respect to claim 18.

C. Claim 26

Claim 26 recites a sheet feeding area that is operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm, and at least one stiff carton ranging in length from 420 mm to 730 mm. On the other hand, Orbons merely discloses feeding rolls of print media, and thus it does not suggest the claimed sheet feeding area that is able to feed a substantially flat sheet of paper or stiff carton.

Moreover, as described above, the paper feed path from the feed unit 2 to the discharge unit 10 contains sharp curves. Therefore, Orbons seems to teach away from feeding a stiff carton for the reasons presented above. Moreover, nothing in the reference suggests the ability to feed a

substantially flat sheet of paper. Accordingly, Appellant submits that claim 26.

Also, Appellant submits that the previous arguments refute the points that the Examiner raises on pages 20 and 21 with respect to claim 26.

D. Claim 31

Claim 31 depends upon claim 26, and thus, it is patentable at least by virtue of its dependency. Also, since Orbons is completely devoid of any teachings regarding the thicknesses recited in claim 31, Appellant submits that the claim is further patentable.

IV. Rejection under 35 U.S.C. § 102(b) over the IP-4000 device publication

Claims 13, 17, 18, 26, and 31 have been rejected under 35 U.S.C. § 102(b) as being anticipated by IP-4000 device publication. Appellant submits that the claims are patentable over the reference.

A. Claim 13

Appellant submits that the arguments presented in the Appeal Brief and the arguments above refute the Examiner's arguments in the Examiner's Answer regarding claim 13.

B. Claim 17

Claim 17 states that, in the printer, the paper feeding area is located in an upper rear portion of the printer, and the paper discharge area is located in a lower front portion of the printer. On page 22 of the Examiner's Answer, the Examiner maintains that the figure in the upper right corner of page 2 of the IP 4000 brochure discloses that the paper discharge area is located at the lower front portion of the printer, but Appellant respectfully disagrees. For

example, as shown on the cover page and the figure that the Examiner references, the discharge area is located at a lower middle portion of the printer.

Accordingly, for the above reasons, as well as the reasons presented in the Appeal Brief, Appellant submits that claim 17 is patentable.

C. Claim 18

Claim 18 states that the printer comprises a paper feeding path that extends straight from the paper feeding area to the paper discharge area via the printing area. The IP 4000 device brochure does not illustrate the paper feeding path from the paper feeding area to the paper discharge area, and thus, the brochure does not suggest the path recited in claim 18. In fact, upon close examination of the location of the direction in which the paper leaves the rollers (in the figure at the middle left of the second page of the brochure) and the location of the paper discharge area (in the upper right figure on the second page), the path probably has substantial curves along the paper feeding path.

Accordingly, for the above reasons, as well as the reasons presented in the Appeal Brief, Appellant submits that claim 17 is patentable.

D. Claim 26

Claim 26 recites a sheet feeding area that is operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm, and at least one stiff carton ranging in length from 420 mm to 730 mm. On the other hand, the IP 4000 device brochure merely discloses feeding rolls of print media, and thus it does not suggest the claimed sheet feeding area that is able to feed a

substantially flat sheet of paper or stiff carton.

Moreover, as described above, the paper feed path probably contains sharp curves, and thus, the brochure seems to teach away from feeding a stiff carton for the reasons presented above. Also, nothing in the reference suggests the ability to feed a substantially flat sheet of paper. Accordingly, Appellant submits that claim 26 is patentable over the reference.

Also, Appellant submits that the previous arguments refute the points that the Examiner raises on pages 22-24 with respect to claim 26.

E. Claim 31

Claim 31 depends upon claim 26, and thus, it is patentable at least by virtue of its dependency. Also, since the IP 4000 device brochure is completely devoid of any teachings regarding the thicknesses recited in claim 31, Appellant submits that the claim is further patentable.

V. Rejection under 35 U.S.C. § 102(b) over the OCE 9400 device

Claims 1, 3, 5, 6, 13, 17, 18, 26, and 31 have been rejected under 35 U.S.C. § 102(b) as being anticipated by OCE 9400 device. Appellant submits that the claims are patentable over the reference.

A. Preliminary comments regarding OCE 9400 device publications

The Microstation Magazine (MSM Online) printout, which describes the OCE 9400 device, is presumably prior art to the present application. However, the Digital ES printout, which describes technical specifications of the OCE 9400 device and which is dated July 2004, clearly is not prior art. Since there is no indication whether or not the features, specifications,

etc. of the OCE 9400 device changed during the seven years that elapsed between the two publications, Appellant submits that the information contained in the Digital ES printout is not prior art and that the rejections relying on this publication are improper on this basis alone. Furthermore, assuming *arguendo* that the Digital ES publication is prior art, Appellant submits that the claims are patentable over the OCE 9400 device.

B. Claim 1

Claim 1 states that the paper feeding unit is operable to feed a stiff carton. The Examiner contends that the Digital ES publication suggests this feature because it states that the printer has a “paper feed by pass and feeds thick originals (stiff carton).” (Page 8 of Examiner’s Answer). Appellant submits that the Examiner is misinterpreting and/or misapplying the teachings of the reference. For example, the publication shows two tables, and the left table has two columns. One row of the left table states “Thick or Solid Originals – Yes”, and another row states “Manual Paper By-Pass – Yes.” Such a vague disclosure clearly does not suggest a stiff carton, let alone a paper feed unit is operable to feed a stiff carton.

For example, page 4 of the Microstation Magazine (MSM Online) printout implies that the OCE 9400 device is a copier and a printer. As such, different components within the device may be used to perform a copying operation and a printing operation. For instance, the OCE 9400 device may be designed such that a user makes a copy by inserting an original document along a guide to a scanner feed table. On the other hand, the device may have a separate paper feeding unit that feeds rolls of paper to be printed and that is different than the scanner feed unit.

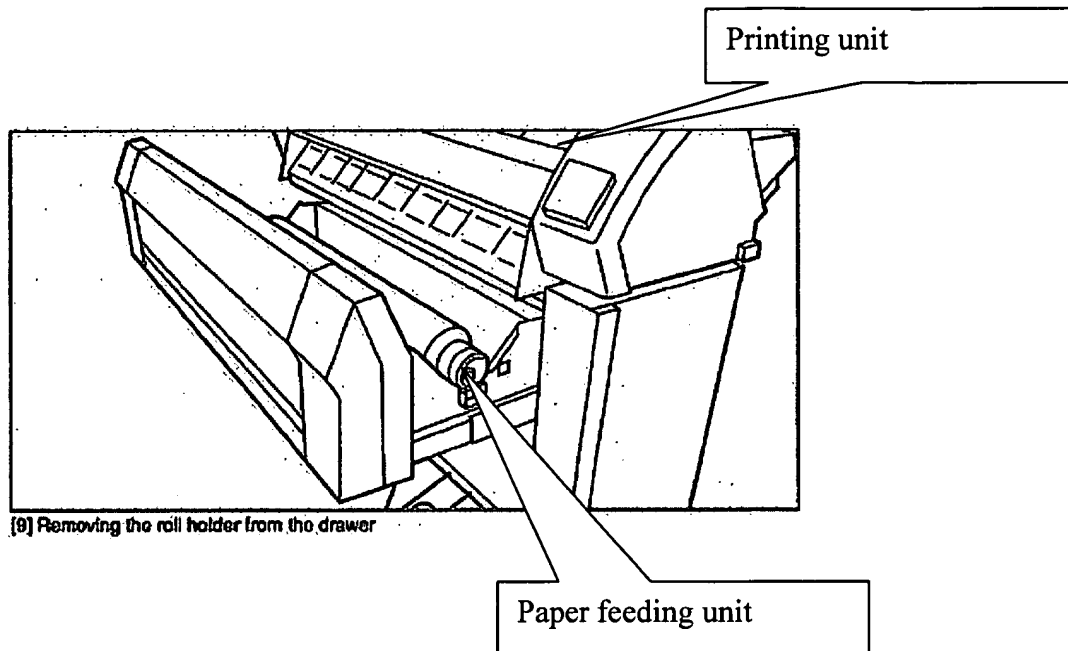
Since the Digital ES publication mentions “Thick or Solid Originals,” it could very well

imply that such originals are originals to be copied via the scanner feed table, rather than print media, which a paper feed unit feeds to be printed. Therefore, even if the vague disclosure of the Digital ES publication suggests a stiff carton, since the OCE 9400 device likely could have a scanner feed table on which the “thick original” is placed, the publication does not suggest that any disclosed paper feeding unit is operable to feed a stiff carton.

Moreover, if the OCE 9400 device has a scanner feed table to scan originals for copying purposes, a paper feeding path clearly would not extend from the scanner feed table to a discharged paper stacking unit via the printing unit. As such, the vague disclosures of the Microstation Magazine (MSM Online) printout and the Digital ES publication further does not suggest the paper feeding unit of claim 1.

Also, claim 1 states that that the printer has a printing unit that is located below the paper feeding unit. On page 7 of the Examiner’s Answer, the Examiner contends that the figure shown on page 4 of the Microstation Magazine (MSM Online) printout showing the OCE 9400 device suggests this feature, but Appellant respectfully disagrees.

Specifically, the figure does not clearly show the location of the printing unit and the paper feeding unit, and thus, one cannot conclusively determine whether or not the printing unit is located above or below the paper feeding unit. For example, as shown in a hypothetical figure for the OCE 9400 device (reproduced below), a roll of paper could be loaded into the paper feeding unit of the OCE 9400 device by opening a drawer, which is located below the printing unit of the device.



Furthermore, if the figure of the OCE 9400 device shown on page 4 of the of the Microstation Magazine (MSM Online) printout suggests anything about the location of the paper feed unit, it seems to show that paper is fed upwards from a compartment or drawer to a printing unit at the top of the device. Based on this suggestion, the OCE 9400 device would seem to have a printing unit that is located above the paper feeding unit. As such, Appellant submits that the Microstation Magazine (MSM Online) printout and the Digital ES publication do not suggest the relative orientation of the claimed units and actually seem to teach away from the claimed orientation.

Also, claim 1 states that the paper feeding path extends in a substantially straight line from the paper feeding unit to the discharged paper stacking unit via the printing unit. However, since page 4 of the Microstation Magazine printout suggests that both the alleged discharge paper stacking unit and the paper feeding unit of the OCE 9400 device are located below the

printing unit, Appellant submits that the paper feeding path does not extend in a substantially straight line as recited in claim 1.

Accordingly, for at least the reasons presented above, Appellant submits that claim 1 is patentable.

C. Claim 3

Since claim 3 contains features that are similar to the features discussed above in conjunction with claim 1, Appellant submits that the claim is likewise patentable over the OCE 9400 device.

D. Claims 5 and 6

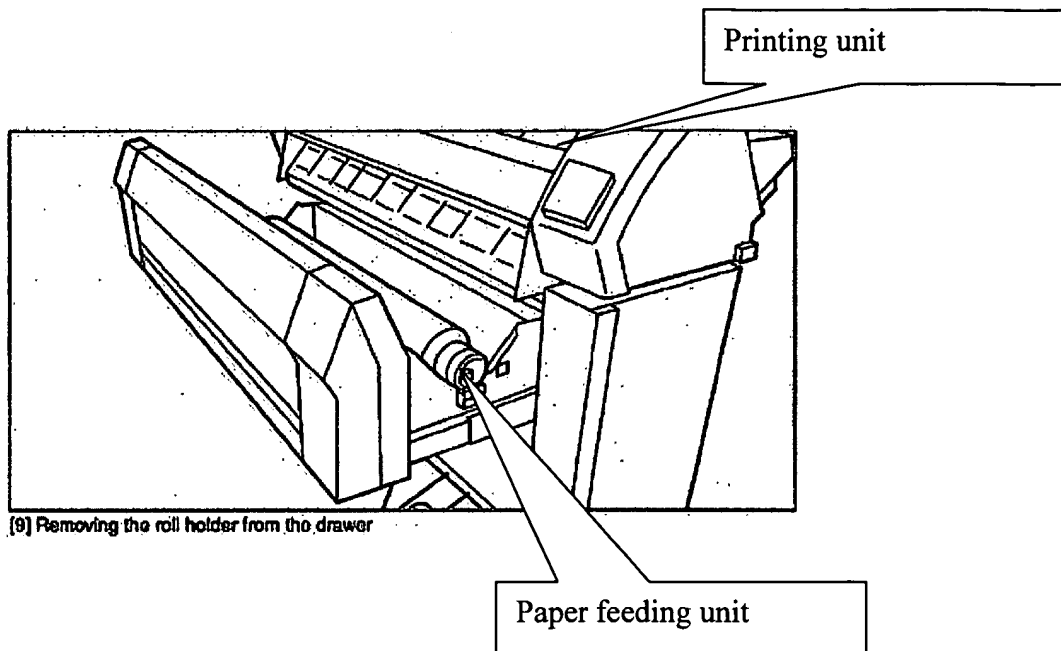
Since claims 5 and 6 depend upon claim 1, Appellant submits that they are patentable at least by virtue of their dependency.

E. Claim 13

Claim 13 states that the printer comprises a sheet feeding area that is positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level. Appellant submits that the OCE 9400 device does not disclose or suggest this feature.

For example, while the Digital ES publication indicates that the height of the printer is 44", this height is the height at the uppermost surface of the printer and not the height of the paper feeding unit. Since the paper feeding unit is likely located well below the printing unit, as shown in the hypothetical figure reproduced below, Appellant submits that the OCE 9400 device

does not disclose the claimed height.



F. Claim 17

Claim 17 states that the paper feeding area is located in an upper rear portion of the printer. On the other hand, as illustrated in the figure above and suggested in the figure contained on page 4 of the Microstation Magazine (MSM Online) printout, the paper feeding unit appears to be located below the printing unit. Therefore, it is not disposed in an upper rear portion of the printer and does not teach the claimed paper feeding unit.

G. Claim 18

Claim 18 recites a paper feeding area having a height that is similar to the height recited in claim 13 and recites a paper feeding path that is similar to the paper feeding path recited in claim 1. Accordingly, Appellant submits that claim 18 is patentable for reasons that are similar to the reasons presented above.

H. Claim 26

Claim 26 states that a sheet feeding unit is operable to feed a paper rolls, a substantially flat sheer of paper, and stiff carton. Appellant submits that the OCE 9400 device does not suggest a sheet feeding area operable to feed a stiff carton for reasons that are similar to the reasons discussed above in conjunction with claim 1.

I. Claim 31

Since claim 31 depends upon claim 1, it is patentable at least by virtue of its dependency. Also, since the OCE 9400 device does not suggest feeding a stiff carton, Appellant submits that it does not suggest a stiff carton having the claimed thickness.

VI. Rejection under 35 U.S.C. § 102(b) over Takumi

Claims 16, 26, and 31 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Takumi. Appellant submits that the claims are patentable over the reference for the reasons presented in the Appeal Brief. Also, Appellant submits that the arguments above refute the points that the Examiner raises on pages 24 and 25 of the Examiner's Answer.

VII. Rejection under 35 U.S.C. § 103(a) over Yamada and Orbons

Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada and Orbons. Since claim 2 depends upon claim 1 and since Orbons does not cure the deficient teachings of Yamada with respect to claim 1, Appellant submits that claim 2 is patentable.

VIII. Rejection under 35 U.S.C. § 103(a) over McCulley and Smedal

Claims 13 and 17 have been rejected as being unpatentable over McCulley and Smedal.

Appellant submits that the claims are patentable over the references.

A. Claim 13

Claim 13 states that the printer comprises a sheet feeding area that is positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level. The Examiner acknowledges that McCulley does not suggest the claimed height but contends that Smedal does.

Appellant respectfully submits that Smedal does not suggest the claimed height of the sheet feeding area for the reasons contained in the Appeal Brief. Also, Appellant further submits that Figs. 3 and 5 of Smedal clearly show that the vertical leg 3 cannot be extended to raise the frame 5 holding the paper rolls 27 to the claimed height. Specifically, as noted in the Appeal Brief, the leg 3 can be extended at any desired elevation within the hollow post 2. (Fig. 5; column 2, lines 86-89). Also, as shown in Fig. 3, the height of the hollow post 2 (including the hollow portion within the base 1) is about one half of the height of a typewriter (shown in phantom lines). Therefore, if the bottom of the leg 3 is extended to the very top of the hollow post 2, the frame 5 positions the rolls 27 slightly above the typewriter.

Clearly, if the typewriter is placed at ground level, the frame 5 would not be positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist. when the user is standing erect in front of the printer

and standing substantially at ground level. Accordingly, claim 13 is patentable over McCulley and Smedal.

B. Claim 17

Since claim 17 depends upon claim 13, it is patentable at least by virtue of its dependency. Also, since both McCulley and Smedal show that the paper discharge area is located above the typewriters, they do not suggest the claimed discharge area that is located in a lower front portion of the typewriter.

IX. Rejection under 35 U.S.C. § 103(a) over Hageman and Metzner

Claim 15 has been rejected as being unpatentable over Hageman and Metzner. Appellant submits that the claim is patentable over the references.

Claim 1 states that a sheet feeding area is operable to feed at least a roll of paper, a sheet of paper and a stiff carton toward a printing unit at which printing is performed thereon. On the other hand, neither Hageman nor Metzner suggest the claimed features.

For example, Fig. 4 of Hageman shows a device that supplies stacked print media (*i.e.*, record strips S and carbon strips C) to a typewriter so that a user can type an original document and simultaneously make a carbon copy of the document. However, as clearly shown in the figure, the recording media S and C significantly bend as the guide plates 42 guide it to the area where the user types onto the media S and C. (Figs. 1, 2, and 4). Accordingly, Hageman teaches away from being able to feed a stiff carton for the reasons mentioned above.

Metzner relates to a device that types information onto a recording medium 14, and the recording medium 14 comprises a stack of record strip elements R and interleaved carbon strip

elements C. As shown in Figs. 1 and 7, the device supplies the recording medium 14 to a recording machine 11 and types information onto the medium 14 as it travels around a platen shaft 97. Then, the device supplies the medium 14 over a booster roller 16 and separates the individual elements R and C of the medium 14. The device respectively feeds the elements R along guides 22 to form refold packs 26 and respectively feeds the elements C along guides 23 towards a spindle 28. (Column 2, line 63, to column 3, line 8).

However, as in Hageman, Fig. 7 of Metzner shows that the recording medium 14 significantly bends around the platen shaft 97. Therefore, Metzner teaches away from being able to feed a stiff carton for the reasons mentioned above.

Also, claim 15 states that the cover member covers a first feeding path for a roll of paper. The Examiner contends that the that housing 45 shown in Fig. 4 of Hageman show this feature, but Appellant disagrees. For example, the housing 45 cover a carbon roll 46, not a roll of paper. Furthermore, as described above, Hageman expressly uses the carbon roll 46 to create a carbon copy of a document along with the document.

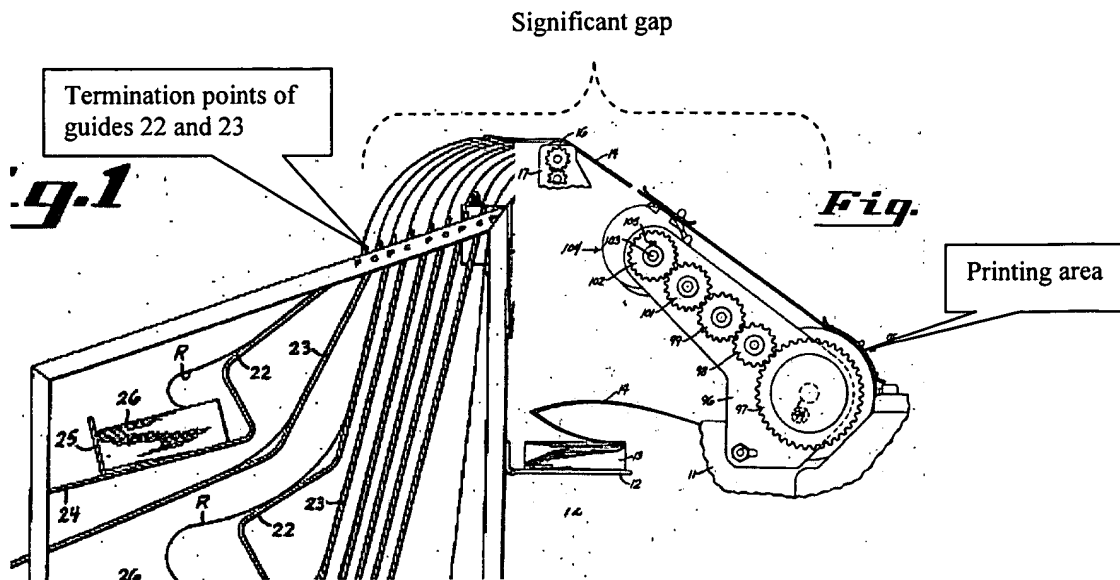
In addition, the Examiner relies on the teachings of Metzner to suggest connecting the Hageman's housing 45 for the carbon roll 46 with Hageman's guide plate 42. (Pages 27-28 of Examiner's Answer). However, Appellant submits that such a modification would contradict the intended operation of the Hageman device. For example, as described on page 3, left column, lines 22-50, and page 4, right column, lines 34-44, of Hageman, the housing 45 has pins 53 which slidably engage slots 54 of the end plates 44 of the carriage 43 so that the housing 45 can be inserted into and removed from the carriage 43. (*See also* Figs. 4 and 5). Thus, when a user

needs to replace the carbon roll 46, he or she removes the entire housing 45 from the carriage 43, replaces the carbon roll 46, and reinserts the entire housing back into the carriage 43. (Page 4, right column, lines 34-44).

Accordingly, if one modified Hageman as the Examiner suggests, the housing 45 would be connected to the guide plates 42 via Metzner's guides 22 and 23, and thus, a user could not remove the housing 45 from the carriage 43 to replace the carbon roll 46.

In addition, the Examiner maintains that one skilled in the art would have been motivated to combine Hageman and Metzner to form one continuous cover member from the paper storage area to the printing unit, but Appellant disagrees. For example, the guide plates 42 and the housing 45 shown in Fig. 4 of Hageman are located upstream from the printing area. On the other hand, the guides 22 and 23 in Metzner are located downstream from the printing area. Thus, one skilled in the art would not look to the teachings of Metzner to modify the upstream guide design of Hageman.

Also, Appellant submits that neither Hageman nor Metzner suggests a continuous cover member between the paper storage area and the printing unit. Specifically, in Hageman, a significant gap exists between the housing 45 and the guide plate 42. Likewise, in Metzner, a significant gap exists between the printing unit and the guides 22 and 23 as shown in the annotated versions of Figs. 1 and 7 (reproduced below).



As shown in the figures, the guides 22 and 23 terminate at the “termination points” and nothing exists to guide the recording medium 14 from the printing area to the guides 22 and 23.

Since neither Hageman nor Metzner suggests a continuous cover member between a paper storage area and the printing area, one skilled in the art would not have been motivated to combine the teachings of the references to create such a continuous member. Accordingly, the Examiner’s proposed motivation to combine the references is improper, and one skilled in the art would not have been motivated to combine the teachings of the references.

SUBSTITUTE REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 09/386,000

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

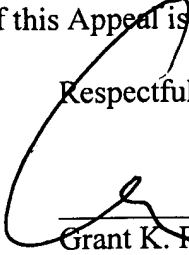
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